

open operative position where the respective candle tools project outside the handle structure; and wherein the candle tools include at least one candle tool taken from the group including an L-shaped wick dipper and a candle swab.

24. The foldable candle tool of claim 23 wherein the candle tools include a retractable wick.

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#### REMARKS

The comments of the Examiner as set forth in the official office action of February 26, 2003 have been carefully studied and reviewed. In this response, claims 3 and 17 have been canceled without prejudice. Claims 1, 8, 11, 12, 13, 15 and 19 have been amended. New claims 21-24 have been added.

First, counsel for Applicant must first acknowledge the manner in which the Examiner has written the office action. In particular, counsel for Applicant is referring to the drawings of the prior art that have been incorporated into the office action in such a fashion that it is very easy for the Applicant to see the prior art that the Examiner is relying on and how the prior art is being applied. The Patent Office is to be commended for encouraging this practice.

In the office action, the Examiner has rejected a majority of the claims under Section 102 in view of the Leatherman patent, U.S. Patent No. 4,238,862 (the '862 patent). In addition, some claims are rejected under Section 103 where the '862 patent forms the primary reference.

The present invention entails a foldable candle tool including a plurality of individual candle tools incorporated into the folding structure. The Examiner does not cite a single reference that discloses a candle tool. However, the Examiner cites the '862 patent which includes a multitude of tools such as pliers, scissors, screwdriver bits, etc. The Examiner's position is that the various tools disclosed in the '862 patent are capable of functioning as candle tools and therefore, in terms of some of the claims, that Applicant's invention is anticipated by the '862 patent.

• With respect to many of the Section 102 rejections, the basic issue presented here is whether candle tools such as wick cutters, wick dippers and candle diggers are met for Section 102 purposes by common everyday tools such as pliers, etc. It is respectfully urged that they are not. The terms wick cutter, wick dipper, candle digger, etc. are technical terms that by their very nature and technical usage define structure, a structure that is not found in the '862 patent. In short, the Examiner has misconstrued the claims and ignored important and material limitations that particularly point out and distinctly claim Applicant's invention and which define over the art including the '862 patent.

Claim 1, as amended herein, is as follows:

A foldable candle tool having a plurality of candle tools incorporated therein, comprising: a foldable handle structure moveable between a folded and closed position and an open and operative position; a series of candle tools mounted to the foldable handle structure with each tool being moveable from a storage position contained within the handle to an open operative position where the respective tools project outside of the handle structure; and wherein the candle tools include at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.

Essentially the position of the Patent Office is that it is irrelevant that Applicant's claims are limited to a candle tool that includes such candle tools as a wick cutter, a wick dipper, a candle digger, etc. This position is taken despite not a single patent cited by the Patent Office shows a candle tool having an array of candle tools taken from the group of a wick cutter, wick dipper, or candle digger. These claim limitations cannot be ignored. See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 U.S.P.Q.2d 1321, 1324, (Fed. Cir. 1987)(the Court cannot ignore a plethora of meaningful limitations). It is fundamental that patentability is determined for the invention as claimed, including all its limitations. It is improper to delete explicit limitations from the claim in order to find the residue in the prior art.

There is a well-known maxim in patent law that relates fundamental principles of infringement with fundamental principles of anticipation. "That which infringes if later anticipates

if earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 U.S.P.Q. 561, 574 (Fed. Cir. 1986). It is inconceivable that any court would find Mr. Williams' claims to his candle tool infringed by the Leatherman tool. The claimed limitations calling for a wick cutter, wick dipper, candle digger, etc. could not be ignored in an infringement action, and they are not properly ignored in a patentability action.

The Patent Office in this case has perused the prior art and has effectively taken the individual candle tools from Mr. Williams' disclosure and placed them on the Leatherman tool. This exercise of hindsight is not "anticipation." The law of anticipation requires that the same invention, with all the limitations of the claims, exist in the prior art. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920-21 (Fed. Cir. 1989) ("anticipation requires that the identical invention is described in a single prior art reference"). A prior art device cannot be altered by the Patent Office and then found to anticipate a different invention in whose image it was recreated.

Attached hereto is a Declaration of Mr. Scott Williams, the inventor of the candle tool of the present invention. Mr. Williams' Declaration provides substantial evidentiary support for the position that the terms wick cutter, wick dipper, candle digger, etc. are technical and structural terms that define elements of the invention not found in the Leatherman patent. The Examiner is urged to consider the testimony of Mr. Williams as set forth in his Declaration. There is no evidence in the record to the contrary.

Mr. Williams' candle tool is not described in the prior art. Statements in the claims that define and limit Mr. Williams' candle tool are material limitations, for purposes of infringement and for purposes of distinguishing from the prior art. See, e.g., *Row v. Dror*, 112 F.3d 473, 478-79, 42 U.S.P.Q. 2d 1550, 1553-54 (Fed. Cir. 1997) (the field of the invention as stated in a Jetson-type claim limits the invention); *Diverstech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1998) (limitations stated in the preamble limit the claimed invention) and *In re Stencel*, 828 F. 2d 751, 754-55, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir.

1987) (function stated in the claim distinguishes from the prior art). In this case, the rejection for lack of novelty is simply incorrect.

In *Warner-Jenkins Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997) the Supreme Court stressed the importance of claim limitations. Counsel for Applicant is aware of a line of cases that stand for the proposition that the discovery of a new use of a known device is not patentable as an apparatus. However, in this case, Mr. Williams' device is not known, but is new, and the claims are explicitly so limited. See *Corning Glassworks v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251, 1255-57, 9 U.S.P.Q. 1962, 1965-66 (Fed. Cir. 1989) ("to read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality"); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (anticipation cannot be based on conjecture). In this case, the claimed candle tool is a novel structure and performs novel functions. In particular, whether the individual candle tools include a wick cutter, wick dipper, or candle digger, these are technical terms and terms that distinguish Mr. Williams' invention from the Leatherman tool. These explicit claim limitations must be considered in determining anticipation, just as they would be considered in construing the claims for the purpose of determining infringement. They cannot be ignored.

The full basis for the Patent Office's anticipation rejection is not altogether clear. In some cases, it is recognized that the doctrine of inherency is utilized in a Section 102 rejection. It is not altogether clear if the Examiner is relying on this doctrine. In any event, an inherent disclosure, in order to be invalidating as an "anticipation" is a disclosure that is necessarily contained in the prior art, and would be so recognized by a person ordinarily skilled in the art. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 U.S.P.Q. 1746, 1749-50 (Fed. Cir. 1991). "Inherency" charges the inventor with knowledge that would be known to the art, although not described. Inherency is not a matter of hindsight based on the Applicant's disclosure, but the missing claim elements must necessarily be present in the prior art.

· As noted above, it is recognized that the discovery of a new use for an old device is unpatentable as an apparatus under Section 102. However, this principle is not on point in this case. The reason for this principle, however, is not "inherency;" it is that the device is already known to the public, and cannot be removed from the public. In this case, however, Mr. Williams has created a new device, not previously known to the public, and has claimed his new device with explicit limitations that distinguish it from previously known devices. Therefore, claims 1-7, 10, 15-17 and 20 are not anticipated under Section 102.

Additionally, claims 8 and 19 stand rejected as being unpatentable over the '892 patent in combination with the Gross patent, U.S. Patent No. 1,047,795. The Examiner acknowledges that the '892 patent does not show the candle scoop. However, the Examiner maintains that it would be obvious to incorporate the spoon of the '795 patent into the '862 patent.

In order to make out a prima facie case of obviousness the burden is of course, on the Patent Office. The Patent Office must make basically two showings to establish a prima facie case of obviousness. First, the Patent Office must show that the primary reference as modified includes each and every element and limitation of a claim. If as modified, the primary reference does not include each and every element and limitation of the claim, there can be no prima facie case of obviousness. Secondly, the Examiner must show that there is a motivation that would induce someone ordinarily skilled in the art to make the combination in the first place and to modify the primary reference in the second place. This should be done on a claim-by-claim and element-by-element basis.

In the case of claims 8 and 19 it is respectfully urged that the Patent Office has not made out a prima facie case of obviousness. For the same reason articulated above, the primary reference, even as modified, does not include the particular candle tools recited and certainly does not include the candle scoop. The Gross patent discloses an eating spoon. That is not a candle scoop. The same arguments as advanced with respect to anticipation is applicable here.

Secondly, and equally important, is the fact that there is indeed no motivation to make this combination. The Examiner articulates the proffered motivation as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the tool of Leatherman with a foldable tool in the form of a spoon as taught by Gross to adapt the combination tool to accommodate various utensils for use at the table.

This alleged motivation is unsupported. There is no substantial evidence supporting such. Nowhere in the prior art, or in the record for that matter, is there any evidence to suggest why a person of ordinary skill in the art would want to make the Leatherman tool an eating utensil. The stated articulation is simply conclusionary. Indeed, it is highly doubtful that anyone would desire to eat with a tool that has connected thereto a pair of pliers and a screwdriver. If for no other reason, a concern for the eating utensil to be in a sterile and sanitary environment would dissuade anyone from modifying Leatherman accordingly. Dirt, grease and other debris normally associated with the Leatherman tools would be less than appetizing and would deter a person of ordinary skill in the art from combining eating utensils with screwdrivers, pliers and the like.

Claims 9 and 18 stand rejected as being obvious in view of Leatherman taken in view of Brown, U.S. Patent No. 5,553,340. Here the Examiner relies on the foldable file 44 and the wire tool 30. Even if there was a motivation in this case, a prima facie case of obviousness is not made out because the wire tool 30 does not assume a generally L-shape. It simply has a slight bend in it. Therefore there is no prima facie case of obviousness here. Further, there is no motivation to combine. The Examiner proffers the following motivation:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool of Leatherman with the following wire tool as taught by Brown, Jr., to adapt a combination tool for cleaning spark plugs and for cleaning hard to reach crevices.

This motivation to combine is unsupported. There is nothing in the prior art that would suggest that it would be desirable to turn the Leatherman tool into something that is not a tool for cleaning spark plugs or for cleaning hard to reach crevices. This motivation is inspired by hindsight and is conclusionary. There is nothing in the Leatherman patent that would suggest the desirability for cleaning spark plugs. Additionally, the Leatherman patent is not about cleaning, but it is about having at hand a number of tools for carrying out work. The tools include pliers, screwdrivers, can openers, scissors and the like. There is not a single cleaning tool on the Leatherman device. In the final analysis, there is in reality no motivation to combine in this case. The fact that references can be combined does not make it obvious to combine them absent a showing that the prior art suggested the desirability of the modification. *In re Laskowski*, 187 F.2d 115, 117 (Fed. Cir. 1989); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Claims 11 and 12 are rejected as being obvious over the Leatherman patent taken in view of the patent to Alexander, U.S. Patent No. 2,496,840. First, claim 12 calls for a sleeve having an extendable and retractable wick incorporated therein. It is not apparent that the wick in Alexander is contained within the sleeve and is extendable and retractable therein. Indeed, Alexander requires the member 20 to be removed and rubbed against the blade to produce sparks in order to light the wick. See column 3, lines 50-57. With respect to motivation, the Examiner states:

It would have been obvious to one of ordinary skill in the art, the time the invention was made, to modify the tool of Leatherman with the lighter as taught by Alexander to adapt the combination tool for sportsman carrying means for igniting a fire.

This articulated motivation is conclusionary and is unsupported. The basis for the motivation is that it would simply be obvious to adapt the Leatherman tool to carry out one more function. Respectfully, that is not how the requirement of motivation works. There must be something in the record from which the Patent Office can base the motivation on. It appears that it is the

Examiner's position that it would be obvious to modify the Leatherman tool with any and all tools or devices found in all of the combination tools of the prior art. That, of course, cannot be the case. In this case, like others discussed above, the Patent Office has simply modified the primary reference of Leatherman based on hindsight.

Finally, the Examiner has rejected claims 13 and 14 as being obvious in view of three patents, the patent to Leatherman, taken in view of the patent to Halverson, U.S. Patent No. 4,204,294, taken in further view of Wells, U.S. Patent No. 4,842,132. The Examiner recognizes that the Leatherman tool does not have a swab, a sleeve holding the swab, or an actuator for extending and retracting the swab from the sleeve. In short, neither Halverson nor Wells teaches a swab. A swab is a wad of absorbent material, usually supported on a support device for removing material from an area. Halverson shows abrasive brushes. Wells shows a brush. There is, indeed, no teaching of the claimed invention in any one of the three references or in the combined teachings of the three references. Thus there can, under no circumstances, be a prima facie case of obviousness here. Again, for the same reasons set forth above, the articulated motivation is flawed. There is no reason to make the Leatherman tool a cleaning tool. There is nothing in the prior art that would urge or induce one skilled in the art to make the Leatherman tool a cleaning tool. This is what Mr. Williams has taught. The Patent Office in formulating this obviousness rejection is attempting to use what Mr. Williams has taught against Mr. Williams himself. In the final analysis, the rejection of claims 13 and 14 based on obviousness is hindsight inspired.

For the foregoing reasons, it is respectfully urged that the present application is in condition for allowance and allowance is respectfully requested.

A check in the amount of \$73.00 is enclosed for the additional claims and a one-month time extension. If additional fees are required please charge them to Deposit Account No. 18-1167.



Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Respectfully submitted,

By:

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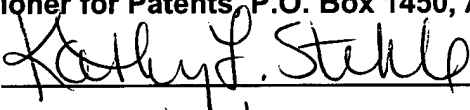
  
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**“Version with markings to show changes made.”**

1. (Amended) A foldable candle tool having a plurality of candle tools incorporated therein, comprising: a foldable handle structure moveable between a folded and closed position and an open and operative position; [and] a series of candle tools mounted to the foldable handle structure with each tool being moveable from a storage position contained within the handle to an open operative position where the respective tools project outside of the handle structure; and wherein the candle tools include at least two candle tools taken from the group including a wick cutter, wick dipper, match holder, candle digger, lighter, swab, and a retractable wick.

8. (Amended) The foldable candle tool of claim 7 further including a candle scoop for scooping wax and debris formed in and around a candle wick and a candle digger for digging into the wax of a candle in and around the wick.

11. (Amended) The foldable candle tool of claim 1 wherein one of the candle tools includes a pre-fueled lighter.

12. (Amended) The foldable candle tool of claim 1 wherein one of the candle tools includes a sleeve having an extendable and retractable wick incorporated therein where the wick functions to light a candle.

13. (Amended) The foldable candle tool of claim 1 wherein one of the candle tools includes a sleeve adapted to receive a swab and wherein the sleeve is provided with an actuator that is effective to extend and retract the swab from the sleeve.

15. (Amended) A foldable candle tool having a series of tools for operating on a candle, comprising:

- g. a pair of handles with each handle having an open channel formed therein;
- h. a wick cutter having a pair of jaws pivotally connected about a pivot pin and including a pair of legs;
- i. each of the legs of the wick cutter being pivotally connected to one end of one handle such that the handles are effectively coupled together by the wick cutter;
- j. the handles being moveable between a closed position where the open channels of each handle face each other and the wick cutter is at least partially housed within opposed channels, and an open position where the wick cutter projects from the two handles; [and]
- k. a plurality of candle tools moveably mounted to the handles with each candle tool moveable from a stored position within one channel to a position where the candle tool projects outwardly from the handle; and
- l. wherein the plurality of candle tools include at least two tools taken from the group including a wick dipper, match holder, candle scoop, candle digger, pre-fuel lighter, wick lighter, and an extendable swab.

19. (Amended) The foldable candle tool of claim 15 wherein the plurality of candle tools includes a wick dipper, an alligator clip, and a candle scoop.